

REMARKS

Claims 9 and 12-18 remain in this application. Of these claims, claims 9 and 18 are independent claims. Claims 9 and 18 have been amended in this response to improve form, and the amendments are in no way related to issues of patentability. No new matter has been introduced.

Claims 9, 12, 14 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Eslambolchi et al.* (US Patent 5,875,422) in view of *Moughanni et al.* (US Patent 5,675,817). Claims 13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Eslambolchi et al.* (US Patent 5,875,422) in view of *Moughanni et al.* (US Patent 5,675,817) and further in view of *Shaffer et al.* (US Patent 6,240,170). Applicant respectfully traverses the rejections. Favorable reconsideration is requested.

Specifically, none of the prior art, alone or in combination, teach “storing selector information designating a language that is allocated to a relevant subscriber for internal subscribers in the communication system” and “automatically activating a loop-in function, when items of the selector information of the calling subscriber differs from the selector information in the called subscriber, which effects an insertion of a translator into the connection” as disclosed in claim 9 and similarly in claim 18.

Claim 9 (and similarly claim 18) pertains to a method in a communication system (KS-B) for translating messages that are directed to a called subscriber (EG-B) into a language that is dependent upon the called subscriber (EG-B). Claim 9 calls for the step of storing selector information (SI-B) designating a language that is allocated to a relevant subscriber (EG-B) for internal subscribers in the communication system (KS-B), and also calls for automatically activating a loop-in function, when items of the selector information (SI-A) of the calling subscriber (EG-A) differs from the selector information (SI-B) in the called subscriber (EG-B), which effects an insertion of a translator (TRSS, TRTT) into the connection. The reference letters inserted into the above claim text and referred to in the above example of Applicant's invention is for reference purposes to the specification and drawings, and is not intended to limit the claims.

In contrast, *Eslambolchi* requires input or action by the user to select or identify a language and to implement or loop-in the language translator. Column 3, lines 15-27 of *Eslambolchi* clearly describes a required input from the user to invoke the language translation service. Following entry by the calling party of the number of the called party, the front end processor 26 prompts the calling party to enter a language translation preference for the speech of the called party. Similarly, *Eslambolchi* et al. at column 3, lines 28-41 describes a voice prompt provided to the calling party to select a language preference for translation. The called party responds by providing input to select the language preference.

Accordingly, there is no "selector information" or "subscriber-specific" storage as required by claims 9 and 18 being implemented in *Eslambolchi*. The prompts taught in *Eslambochi* are universally accessed by users, regardless of their language capabilities. Furthermore, the Office Action has conceded that *Eslambolchi* does not disclose "automatically activating a loop-in function, when items of the selector information of the calling subscriber differs from the selector information in the called subscriber, which effects an insertion of a translator into the connection" (Page 3 of Office Action, second full paragraph)

In this regard, *Moughanni* was cited as teaching the feature of automatically activating a loop-in function. However, this position misinterprets the teaching in *Moughanni*. *Moughanni* discloses that the language of an incoming information is determined from "function bits" or an "information value" (see column 4, lines 46 to 53). The preferred language of a pager receiving the information can be determined by a "value" in a "command control register". If the language of the incoming information does not match the preferred language of the pager, the incoming bits of information are automatically translated. Thus, *Moughanni* does not teach to automatically loop-in a translation into the connection dependent on bits of selector information indicating the languages of the dialog user interfaces of the telephones of the calling and the called subscriber. Accordingly, the teachings in *Moughanni* does not cure the deficiencies of *Eslambolchi*, discussed above.

Furthermore, the Office action improperly combined the aforementioned references and relied on impermissible hindsight in formulating the rejection. There is no teaching or suggestion for one of ordinary skill in the art to combine the teaching of *Moughanni* with that of

Eslambolchi in the manner suggested by the Examiner. For example, *Eslambolchi* is premised upon a system where a calling party invokes an automatic language translation service (by dialing the number associated with that service), and the service prompts the calling party to enter the number of each called party and a language translation preference for the information generated by that called party. Thereafter, a connection is established with the called party who is then prompted to enter a language preference for the information generated by the calling party (col. 1, lines 46-54). In contrast, *Moughanni* discloses a paging system utilizing a POCSAG protocol to code/decode paging signals sent between users (col. 3, line 63 – col. 4, line 13). There is no teaching suggestion or motivation to combine these references as they relate to divergent technologies. Since the teaching in *Eslambolchi* uses a special dial-in number, there would be no reason for one skilled in the art to rely on the POCSAG embodiment disclosed in *Moughanni* to purportedly arrive at the claimed invention.


The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In light of the above amendments and arguments, Applicants submit that the above rejections are improper and should be withdrawn. Should the Examiner choose to maintain the rejections, the Applicant respectfully requests, as of right, an Examiner Interview. Accordingly, claims 9 and 12-18 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. A petition for a three-month extension of time, along with a check in the amount of \$1,020.00 is enclosed herein. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-078.

Respectfully submitted,
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